



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Patent Cooperation Treaty
Legal Office

Address: Assistant Commissioner for Patents
Box PCT
Washington, D.C. 20231

03 AUG 1999

Nils E. Pederson
WENDEROTH, LIND & PONACK, L.L.P.
2033 "K" Street N.W.
Suite 800
Washington, DC 20006

In re Application of :
Udo NOBEL, et al. :
Serial No.: 09/068,238 :
PCT No.: PCT/IT96/00202 :
Int. Filing Date: 04 November 1996 :
Priority Date: 06 November 1995 :
For: WINDOW WITH GLAZING PROFILE :

DECISION

This decision is in response to applicants' "RESPONSE TO NOTIFICATION OF A DEFECTIVE RESPONSE" filed 11 January 1999. The Response is being treated as a petition under 37 CFR 1.181 for withdrawal of the Notification of a Defective Response mailed by the Office on 10 December 1998. No petition fee is required.

BACKGROUND

On 04 November 1996, applicants filed international application PCT/IT96/00202, which claimed priority of an earlier Italian application filed 06 November 1995. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 15 May 1997. A Demand for international preliminary examination, in which the United States was elected, was filed prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee to enter the national stage in the United States expired at midnight on 06 May 1998.

On 06 May 1998, applicants filed a Transmittal Letter for entry into the national stage in the United States under 35 U.S.C. 371. Filed with the Transmittal Letter were, inter alia, the requisite basic national fee and a copy of the international application published in English as required by 35 U.S.C. 371(c)(1) and (2).

In response to the Notification of Missing Requirements (Form PCT/DO/EO/905) issued by the Office on 03 September 1998, applicants filed on 29 September 1998 two declarations, each executed separately by one of the two joint inventors in the application.

On 10 December 1998, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of a Defective Response (Form PCT/DO/EO/916), which informed applicants that the declaration(s) filed on 29 September 1998 "does not comply with 37 CFR 1.497(a) and (b) in that it does not identify the inventor(s)."

On 11 January 1999, applicants filed the present petition asserting that "the declarations submitted comply with 37 CFR 1.497(a) and (b) and withdrawal of the Notification of a Defective Response is respectfully requested." Applicants argue that "The declaration in this application was submitted as two separate declarations by the respective inventors. Each declaration lists the respective inventor. Thus, the declarations identify the inventors." Then, on 26 March 1999 two supplemental declarations, in which both inventors were listed, were provided.

DISCUSSION

Applicants' arguments have been carefully considered but are not convincing. The MPEP at 1893.01(e) states that "Applicants entering the national stage in the U.S. are required to file an oath or declaration of the inventor in accordance with 37 CFR 1.497(a), (b) and 1.63."

37 CFR 1.497(a)(3) and (b) clearly stipulates the following:

(a) When an applicant of an international application desires to enter the national stage under 35 U.S.C. 371 pursuant to §§ 1.494 or 1.495, he or she must file an oath or declaration that:

... (3) Identifies each inventor and the country of citizenship of each inventor; and

(b) The oath or declaration must be made by all of the actual inventors except as provided for in §§ 1.42, 1.43 or 1.47.

37 CFR 1.63(a)(4) also requires that

(a) An oath or declaration filed under § 1.51(b)(2) as a part of an application must:

... (4) State whether the inventor is a sole or joint inventor of the invention claimed.

A review of the application file reveals that the declarations executed by each of the joint inventors failed to list the name of the other joint inventor as required by 37 CFR 1.63(a)(4). Each declaration asserts that the inventor executing the declaration is the sole

inventor, and thus is defective for failure to list all the inventors as required by patent rules and regulations. Accordingly, the Notification of a Defective Response of 10 December 1998 was properly issued.

DECISION

In view of the discussion above, the petition under 37 CFR 1.181 requesting withdrawal of the Notification of a Defective Response mailed by the Office on 10 December 1998 is DISMISSED, without prejudice.

The application is being returned to the DO/EO/US for further processing in view of the supplemental declarations filed 26 March 1999. Applicants are hereby notified that the submission of the declarations on 26 March 1999 is beyond the five months extension available under 37 CFR 1.136(a). Accordingly, the application is ABANDONED as to the national stage in the United States as of midnight on 03 October 1998.



Leonard E. Smith
PCT Legal Examiner
PCT Legal Office

NNH/LES:hn



Nguyễn Ngọc-Hồ
Paralegal Specialist
PCT Legal Office

Tel: (703) 308-6508